

REMARKS

Claims 1-46 are pending, with claims 1, 16, 23, 31, 39 and 45 being independent. Claims 1, 4, 5, 11, 23, and 42-46 have been cancelled by this amendment without prejudice. Claims 2, 24, and 39 have been amended. New claims 47-56 have been added. No new matter has been added. Reconsideration and allowance of the above-referenced application are respectfully requested.

Provisional Double Patenting Rejection

Claims 1-46 stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-57 of copending Application No. 10/699,124. This rejection is respectfully traversed.

The Office Action asserts that the allegedly conflicting claims are not patentably distinct from each other because:

all the limitations of independent claims 1, 23, 39, and 45 of the present application are found in claims 52 and 54 of the copending application 10/699,124 except for the underlined portion: to force the action to be taken "with respect to the second electronic document". It would have been obvious to one of ordinary skill in the art at the time the invention was made to force the action to be taken with respect to third electronic document rather than the second electronic document as it is disclosed in claim 32 that document permissions information may comprise policy such as document revocation list.

See 06/01/2007 Office Action at page 3. However, the fact that the offline access information claimed in Application No. 10/699,124 includes a document revocation list does not support a conclusion of obviousness for forcing an action requested for a first document to be taken with respect to a second document.

A revocation list indicates one or more documents that have been revoked, but need not include any information regarding other document(s) that can be substituted for the revoked document(s). Moreover, even if such information were included in a revocation list, the natural use of such information would be to advise the user of the newer document, not to force the previously requested action with respect to the newer document. In fact, forcing an action, which was requested with respect to a revoked document residing on a user's computer, to be taken with respect to a newer version of the document retrieved via a network connection is counterintuitive and defies common sense since it presupposes the right of a server to override and redirect a user's requested action on a local document on the user's local computer. Similar arguments are applicable to independent claims 16 and 31.

Furthermore, the provisional double patenting rejection is improper because it fails to fully determine the differences between the scope of the claims in the current application and those in Application No. 10/699,124, as required by MPEP 804(II)(B)(1). For example, original claim 1 recites:

receiving a request to take an action with respect to a distributed electronic document;

identifying, in response to the request, information associated with the distributed electronic document, the associated information indicating a second electronic document different from the distributed electronic document; and
imparting information concerning the second electronic document to force the action to be taken with respect to the second electronic document.

See Original Claim 1. In contrast, claim 52 in Application No. 10/699,124 recites:

a document control server that synchronizes offline access information with a client in response to a client request, the offline access information comprising a first key associated with a group, the first key being useable at the client to access an electronic document by decrypting a second key in the electronic document; and

the client that allows access to the electronic document, when offline, by a user as a member of the group, using the first key to decrypt the second key in the electronic document and governing actions with respect to the electronic document based on document-permissions information associated with the electronic document;

wherein the client request comprises a request from the client to take an action with respect to a second document.

See Original Claims 45 and 52 in Application No. 10/699,124 (emphasis added). The underlined claim language above represents differences between the scope of the claims in the current application and those in Application No. 10/699,124, which differences have not been addressed.

The one-way obviousness standard is “whether the invention defined in a claim in the application would have been [...] an obvious variation of the invention defined in a claim in the patent.” *See* MPEP 804(II)(B)(1)(a). The provisional double patenting rejection of claims 1, 23, 39, and 45 based on claims 52 and 54 of Application No. 10/699,124 does not meet this standard

since it disregards elements of claims 52 and 54 of Application No. 10/699,124. Under a one-way obviousness-type double patenting rejection, the Office must consider these differences between the scope and content of the claims in the respective cases and explain why it would be obvious to remove such limitations from the other application's claims, in addition to adding the new limitations of the present application's claims.

In the present case, the subject matter of claims 1, 23, 39, and 45 would not have been an obvious variation of the subject matter of claims 52 and 54 of Application No. 10/699,124 since these claims in the respective cases include substantial differences, which have not been addressed by the Office, and which correspond to separately patentable inventions. Similar arguments are also applicable to claims 16 and 31 in the present application. Thus, in view of the arguments presented above, withdrawal of the provisional double patenting rejection is respectfully requested.

Rejections under 35 U.S.C. §§ 102 & 103

Claims 1-3, 5-43, and 45-46 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by US Patent Publication US2002/0087876 to Larose. Claim 4 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Larose. Claim 44 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Larose in view of PageRecall: The Key to Document Protection, Authentica, Inc. Whitepaper (hereinafter, "PageRecall"). These rejections are respectfully traversed.

The rejection of claims 1, 4, 5, 11, 23, and 42-46 has been obviated by the cancellation of these claims without prejudice.

Examiner Colin is thanked for the interview, which was conducted with Mr. Hunter on August 29, 2007. During the interview, claims 1, 16, 23 and 31, and the Larose reference were discussed. Mr. Hunter explained the differences between the claimed subject matter and the teachings of Larose.

Larose describes a system for providing security for programs installed in a computer in which:

the original program is divided into versions of increasing functionality and in which higher functioning versions depend upon and utilize security-related attributes of the computer on which the program is to be executed. The versions are installed on the user's computer. Upon initiation of execution of the lowest functioning version, the security-related attributes of the user's computer are inspected and the execution of the second version is initiated in the place of the first version if the security-related attributes of the second computer support the increased functionality of the second version. If so, the security-related attributes are used in the second version prior to execution. In either case, the remaining version is then executed without the need for further intervention for security purposes.

See Larose at page Abstract (emphasis added). The inspection of attributes is performed at the user's computer, and if the inspection identifies relevant attribute(s), the next higher version of the software is loaded before the user's computer runs the binding functions for that next higher version. *See* Larose at FIGs. 1, 2, 3 and 5, and corresponding description.

In contrast, claim 2 is directed to controlling access to distributed documents. Claim 2 recites:

receiving a request to take an action with respect to a distributed electronic document;

identifying, in response to the request, information associated with the distributed electronic document, the associated information indicating a second electronic document different from the distributed electronic document; and

imparting information concerning the second electronic document to force the action to be taken with respect to the second electronic document;

wherein receiving the request comprises receiving, at a server, the request from a client to take the action with respect to the distributed electronic document, wherein the distributed electronic document is retained locally at the client, identifying the associated information comprises identifying associated information at the server, and imparting the second document information comprises relating the second document information from the server to the client.

See Claim 2 (emphasis added). Thus, the client sends a request to the server when an action is to be taken with respect to a distributed document that is retained locally at the client, and the server identifies the associated information at the server and sends back the second document information to the client to force the action to be taken with respect to the second electronic document.

Larose fails to teach or suggest this subject matter as claimed. The receiving and identifying operations identified in Larose all occur at the “execution processor 250” (i.e., the client computer). It should be noted that paragraph [0092] in Larose does describe contacting a server, but this is done with respect to the “decisions about making the next levels available”,

which is referring to authorization and e-cash capabilities. The fact that a next level/version of the software exists is already known at the client computer, and the determination that this next level/version of the software can be installed because the relevant attribute(s) have been identified on the computer has already been performed at the client computer, when the server is contacted in Larose. Larose fails to teach or suggest linking a document distributed to a client computer with a server such that, when an action is requested with respect to the distributed document, the server is contacted to check if the server has access to information associated with the distributed document, which information specifies a second document that the requested action should be applied to, rather than the distributed document. Thus, for all of the above reasons, independent claim 2 should be allowable over Larose.

Independent claim 24 should also be allowable over Larose for the same reasons as claim 2. Dependent claims 3, 6-10, 12-15, 25-30, and 48-51 should be allowable based on the above arguments and the additional recitations they contain. For example, claims 7 and 27 recite, "wherein the second electronic document comprises a later version of the distributed electronic document, and the associated information comprises document-permissions information specifying that the action is not permitted with respect to the distributed electronic document at the client." (Emphasis added.) Claims 8 and 48 recite, "wherein the document-permissions information specifies access permissions at a level of granularity smaller than the distributed electronic document." (Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose fail to support the rejection of this claimed subject matter.

Claims 9 and 28 recite, “wherein the associated information comprises user-dependent association information indicating the second electronic document, and obtaining the second electronic document comprises identifying the second electronic document based on the user-dependent association information and an identified user at the client.” (Emphasis added.)

Claims 10 and 29 recite, “wherein obtaining the second electronic document further comprises generating at least a portion of the second electronic document based on the identified user.”

(Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose fail to support the rejection of this claimed subject matter.

Claims 15 and 51 recite, “wherein the second document includes the address of the server and a second document identifier, and replacing the distributed document further comprises writing over the distributed document with the second document in a storage device.” (Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose fail to support the rejection of this claimed subject matter.

Independent claims 16 and 31 should also be allowable over Larose for at least reasons similar to claim 2. In particular, claims 16 and 31 recite, “opening a locally retained distributed document; contacting a document control server identified from the distributed document; and forcing use of a second document in place of the distributed document, with respect to at least one document action, based on information received from the document control server.”

(Emphasis added.) In addition, nothing in Larose suggests contacting a document control server, as claimed. Thus, for all of the above reasons, independent claims 16 and 31 should be allowable over Larose.

Dependent claims 17-22, 32-38, and 47 should be allowable based on the above arguments and the additional recitations they contain. For example, claims 20 and 35 recite, “wherein forcing use further comprises transparently overwriting the distributed document with the second document.” (Emphasis added.) Claims 21 and 36 recite, “wherein the received information comprises document-permissions information specifying permissions relating the second document with the distributed document.” (Emphasis added.) Claims 37 and 47 recite, “wherein the document-permissions information specifies access permissions at a level of granularity smaller than the distributed document.” (Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose fail to support the rejection of this claimed subject matter.

Independent claim 39 should also be allowable over Larose for at least reasons similar to claim 2. In particular, claim 39 recites, “a client operable to send a request to a server when an action is to be taken with respect to a distributed electronic document local to the client; and a server operable to receive the request, and in response to the client, the server being operable to identify information associated with the distributed electronic document, the associated information indicating a second electronic document different from and associated with the distributed electronic document, the server being operable to relate information concerning the second electronic document to the client to force the action to be taken with respect to the second electronic document.” (Emphasis added.) Thus, for all of the above reasons, independent claim 39 should be allowable over Larose. Dependent claims 40, 41, and 52-56 should be allowable based on the above arguments and the additional recitations they contain. For example, claims

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52, 53, 54, 55, and 56 should be allowable for at least reasons similar to claims 7, 8, 9, 10, and 15, respectively.

Conclusion

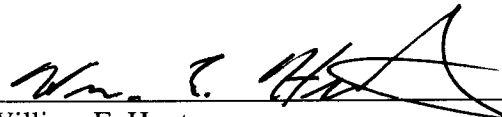
The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

A notice of allowance is respectfully requested. No fees are believed due with this response. However, please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: _____

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